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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/638,848	08/11/2003	Ellen Myra Dobrusin	5716-D1	4448

28880 7590 05/06/2005

WARNER-LAMBERT COMPANY  
2800 PLYMOUTH RD  
ANN ARBOR, MI 48105

EXAMINER
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TRUONG, TAMTHOM NGO

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/638,848

Applicant(s)

DOBRUSIN ET AL.

Examiner

Tamthom N. Truong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8-11-03 & 11-3-03
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

Claims 1-6 are pending.

It is noted that applicants claim priority to US application 9/623,737, which is a 371 of PCT/US 99/10187, which also claims priority to Provisional Applications of 60/086,708 and 60/126,158. However, said priority has been adversed by the Board of Patent Appeal and Interference as per the decision of 3-31-04 (in US application 09/623,737).

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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1. Claims 1-4 & 6 are rejected under 35 U.S.C. 102(e) as being anticipated by **Harris et. al.** (US 6,150,373 – cited on IDS). Harris et. al. disclose many compounds of substituted 3,4-*dihydro-pyrimido[4,5-d]pyrimidin-2(1H)-one* that read on the instantly claimed formula. For example, the compounds in Examples 17, 18 and 21 fall within the instantly claimed formula having the following substituents:

- i.  $R^1$  is  $C_1$ -alkyl, or  $(CH_2)_nAr$ ;  $n = 1$  or  $2$ ;
- ii. Ar is phenyl unsubstituted or substituted with alkoxy;
- iii.  $R^2$  is  $C_1$ -alkyl, or  $(CH_2)_nAr$ ;  $n = 0$ ; Ar is unsubstituted phenyl;
- iv.  $R^3$  is  $(CH_2)_nAr$ ;  $n = 0$ ; Ar is phenyl substituted with halogen.

The process recited in claim 4 is anticipated since the above examples disclose a process having a starting material with a leaving group of *methanesulfonyl* at the 7<sup>th</sup> position which reacts with an amine that reads on the formula  $R^1-NH_2$ . The instant composition claim is also anticipated since the disclosed compounds have pharmaceutical use as well.

2. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by **Dunn et. al.** (US 6,642,241 B1). On column 27, Dunn et. al. disclose compound 4d which reads on the instantly claimed formula with the following substituents:

- v.  $R^1$  is  $C_3$ -alkyl (or isopropyl);
- vi.  $R^2$  is  $C_2$ -alkyl substituted with hydroxyl;
- vii.  $R^3$  is  $(CH_2)_nAr$ ;  $n = 0$ ;
- viii. Ar is phenyl substituted with halogen.

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The processes recited in the instant claims 4 and 5 are also anticipated by the process described on column 26 because the term "comprising" in said claims allows for additional steps and intermediates. The instant composition claim is anticipated as well since the disclosed compound has therapeutic use.

No pending claims are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 571-272-0676. The examiner can normally be reached on M-F (10:00-6:30).

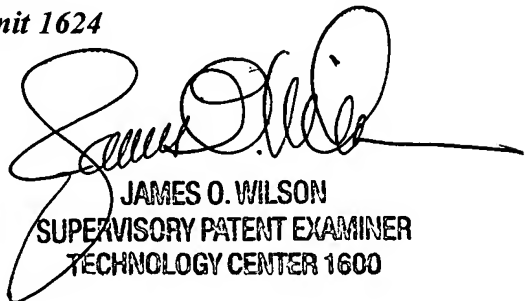
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**Tamthom N. Truong**  
Examiner  
Art Unit 1624

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4-28-05

  
**JAMES O. WILSON**  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600